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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,588	02/27/2002	Eran Macover	2069/3	1400
7590	09/11/2006			EXAMINER
DR. MARK FRIEDMAN LTD. c/o Bill Polkinghorn Discovery Dispatch 9003 Florin Way Upper Marlboro, MD 20772			JOHNSON, JONATHAN J	
			ART UNIT	PAPER NUMBER
			1725	
DATE MAILED: 09/11/2006				

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/083,588
Filing Date: February 27, 2002
Appellant(s): MACOVER, ERAN

MAILED
SEP 11 2006
GROUP 1700

Mark M. Friedman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10-18-05 appealing from the Office action mailed 2-23-05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

10/740,634, is a divisional of the instant application and an appeal brief was also filed on 10-18-05.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 3 and 4.

Claims 1 and 2 have been canceled.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,049,506	Gilding	9-1977
4,950,365	Evans	8-90

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilding (4,049,506) in view of Evans (4,950,365). Gilding teaches preparing a wire bonding capillary by providing a wire bonding capillary for pressing wire against an electrode pad comprising a capillary tip having a pressing face (Figure 3, item 13) made of a hard metal such as ruthenium or titanium carbide (col. 7, ll. 40-45 and col. 8, ll. 40-45) and coating the hard metal with a silicone to provide a protective coating (col. 2, ll. 24-26, col. 8, ll. 10-2, and figure 2, item 16).

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Gilding does not teach the silicone material is a thermoplastic or poly-p-xyllylene. Evans teaches using a using of a poly-p-xylene over a hard metal layer such as titanium carbide (col. 4, ll. 2-10). It would have been obvious to one of ordinary skill in the art at the time of the invention to replace the protective coating of Gilding with the poly-p-xylene coating in order to obtain good corrosion resistance even after substantial use (see Evans column 3, Lines 59-65). While the examiner agrees that the polymer coating will likely wear off the surface of the capillary tip during its first use, it is the examiner's position that, in the time just prior to the polymer coating wearing away, the combined invention of Gilding and Evans meet the claim limitation of "coating all of the pressing face of said capillary" as the polymer layer coats the capillary tip.

(10) Response to Argument

Appellant argues that Evans does not teach the use of parylene to prevent the buildup of contaminants deposited on the surface of the tip and the bore of a wire bonding capillary. The examiner agrees. Appellant goes on to argue that because Evans does not recognize his use, then there can be no motivation to combine. The examiner disagrees. The prior art references need not be combined for same problem recognized by the appellant. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992). That is, motivation in the prior art to combine the prior art teachings does not have to be identical to that of the appellant to establish a *prima facie* case of obviousness. In re Kemps, 97 F.3d 1427, 1430, 40 U.S.P.Q.2d 1309, 1311 (Fed. Cir. 1996). As indicated in above, one of ordinary skill in the art would have motivation to utilize Evans' poly-p-xylene coating in order to obtain good corrosion resistance (see Evans column 3, Lines 59-65).

Appellant next argues that Evans teaches that the residual parylene remaining in the cracks of the metal surface after the rest of the parylene has been worn off is effective at inhibiting corrosion. The examiner agrees. Appellant next argues that, in his invention, the parylene resists contaminant deposits on the surface of the tip and bore of a wire bonding capillary. The examiner agrees. Appellant then argues that although Evans is effective in preventing corrosion of a metal substrate, Evans would be totally ineffective in preventing contamination buildup on the tip of the wire bonding capillary. That is, appellant argues there is no likelihood of success that Evans would be effective in preventing contamination buildup on the tip of the wire bonding capillary.

While appellant, arguably, may be correct, appellant does not claim this limitation. Instead, appellant claims "coating all of the pressing face of said capillary tip with a layer of polymeric material." Gilding teachings coating the capillary tip with a silicone material (Gilding, col. 2, ll. 24-26, col. 8, ll. 10-2, and figure 2, item 16), but Gilding does not teach that the silicone material is a thermoplastic or poly-p-xylylene. Evans teaches coating the surface when it states the "outer [polymeric] layer is almost immediately worn off of the surface of the substrate." (Evans, col. 4, ll. 15-17). Implicit in this teaching is that the polymeric layer coats the surface prior to it being worn off the surface of the substrate. As stated in the final office action, it is the examiner's position that, in the time just prior to the polymer coating wearing away, Gilding in view of Evans meet the claim limitation of "coating all of the pressing face of said capillary."

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jonathan Johnson
Primary Examiner, AU 1725



Conferees:

Pat Ryan, S.P.E. AU 1725



Steve Griffin, S.P.E., AU 1731

